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Paper 39

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

GAIL W. WERTZ,
QINGZHONG YU, LAURENCE A. BALL,
JOHN N. BARR, and SEAN P.J. WHELAN

Junior Party,
(Patent 5,789,229),

v.

JOHN K. ROSE

Senior Party,
(Application 08/435,032).

Patent Interference No. 104,421

Before, SCHAFER, TORCZON, and LANE, Administrative Patent Judges.

LANE, Administrative Patent Judge.

FINAL JUDGMENT

A paper entitled DECISION OF THE ARBITRATOR ON PRELIMINARY MOTIONS
was filed 22 April 2002 (Paper 31). A paper entitled FINAL DECISION OF THE

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ARBITRATOR was filed 25 March 2003 (Paper 38). Pursuant to the parties' agreement to arbitrate under 37 CFR § 1.690 (Paper 28) and for other reasons given, Count 2 is substituted for Count 1 and judgment on priority as to Count 2 is entered against junior party Wertz.

I. Background

The interference

1. The interference was declared on 9 August 2000 (Paper 1) between junior party Gail W. Wertz, Qingzhong Yu, Laurence A. Ball, John N. Barr, and Sean P.J. Whelan ("Wertz") and senior party John K. Rose ("Rose").

2. The interference was declared with the following count ("Count 1") (Paper 1 at 50):

A composition of matter according to claims 1, 6, or 11 of
Wertz (5,789,229)

or

a composition of matter according to claims 75, 103, or 132
of Rose (08/435,032).

3. Wertz claims 1, 5, 6, 10, 11, 14, and 15 were designated as corresponding to Count 1 (Paper 1 at 50).

4. Rose claims 75-99 and 101-132 were designated as corresponding to Count 1 (Paper 1 at 50).

Arbitrator's decision on preliminary motions

5. According to the arbitrator's decision on preliminary motions (Paper 31), Rose filed a preliminary motion to modify the count and a preliminary motion asserting that Wertz claim 11 is unpatentable.

6. The arbitrator determined that the count should be modified to the following ("Count 2") (Paper 31 at Appendix B, brackets in original):

A virus particle of claim 1, wherein the non-segmented RNA virus is vesicular stomatitis virus (VSV). [Wertz claim 5]

OR

A virus particle of claim 6, wherein the non-segmented RNA virus is vesicular stomatitis virus. [Wertz claim 10]

OR

A modified recombinant replicable vesiculovirus, comprising vesiculovirus N, P, and L proteins, and a replicable vesiculovirus genomic sense (-) RNA, in which said genomic sense (-) RNA, is modified by:

- (a) the insertion of a foreign or heterologous RNA sequence into a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA; or
- (b) the replacement of a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA with a foreign or heterologous RNA sequence;

in which an RNA sequence complementary to said foreign RNA sequence encodes a peptide or protein. [Rose claim 75, as amended]

OR

A modified inactivated recombinant vesiculovirus that is the produce of a method comprising inactivating a recombinant replicable vesiculovirus, said recombinant replicable vesiculovirus comprising N, P, and L proteins, and a replicable vesiculovirus genomic sense (-) RNA, in which said genomic sense (-) RNA, is modified by:

- (c) the insertion of a foreign or heterologous RNA sequence into a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA; or
- (d) the replacement of a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA with a foreign or heterologous RNA sequence;

in which an RNA sequence complementary to said foreign RNA sequence encodes a peptide or protein. [Rose claim 103, as amended]

OR

A pure, recombinant, replicating and infectious vesicular stomatitis virus (VSV) particle, comprising:

- 1) a functional RNA dependent RNA polymerase (L);
 - 2) a vesiculovirus phosphoprotein (P);
 - 3) a vesiculovirus nucleocapsid (N);
 - 4) vesiculovirus protein selected from the group consisting of glycoprotein (G) and matrix (M)
 - 5) a 3' non-coding RNA sequence;
 - 6) a 3' to 5' RNA coding sequence, which encodes the vesiculovirus L, P, N, and vesiculovirus protein required for assembly of budded infectious particles and includes a heterologous gene (X), wherein said heterologous gene (X) is inserted at an intergenic junction; and
 - 7) a 5' non-coding RNA sequence, and wherein components 1 through 7 are from the same type of VSV. [Rose claim 132, unamended]
7. Count 2 does not contain Wertz claim 11 which is part of Count 1.
 8. Count 1 contains Rose claims 75 and 103, whereas Count 2 contains modified versions of Rose claim 75 and 103.¹
 9. The arbitrator's decision on preliminary motions indicates that only Wertz claims 1, 5, 6, and 10 are appropriately designated as corresponding to Count 2.
 10. Accordingly, the arbitrator did not decide whether Rose had shown that Wertz claim 11 is unpatentable (Paper 31 at 2).
 11. The arbitrator's decision on preliminary motions indicates that Rose claims 75-99 and 101-132 are appropriately designated as corresponding to Count 2.

¹ The arbitrator's decision and Count 2 refer to "amended" claims 75 and 103. However, it does not appear that Rose moved before the arbitrator to amend the claims under 37 CFR § 1.633(c). Therefore, we understand the arbitrator's use of the term "amended" to refer to the Rose claims as they appear in the count and not as they appear in the Rose application.

The arbitrator's decision on priority

12. The arbitrator's decision on priority indicates that, as to Count 2, junior party Wertz has not proven an actual reduction to practice prior to Rose's constructive reduction to practice and that Wertz has not proven a conception prior to Rose's conception (Paper 31 at 2).
13. Accordingly, the arbitrator determined that Wertz was not entitled to judgment on priority as to its claims that correspond to Count 2 (Paper 31 at 9).

Rose terminal disclaimer and amendment

14. Pursuant to requirements set forth in the Order entered 24 April 2002 (Paper 32), Rose filed:

- (1) a terminal disclaimer under 37 CFR § 1.321(b) disclaiming a portion of the term of any patent issuing from its involving application equal to the amount of time between 9 August 2002 and the date the final arbitrator's decision is filed, and
- (2) a paper canceling claim 100 in Rose's 08/435,032 application.²

II. Discussion

The parties have agreed that the arbitrator's decisions shall be binding on the parties and that judgment thereon can be entered by the Board. (See 37 CFR § 1.690(a) and Paper 28). The arbitrator's decisions are dispositive as to the parties and have been considered by the Board. 37 CFR § 1.690 (c).

² The pendency of the interference before the Board of Patent Appeals and Interferences exceeded two years due to delay by the parties. Requiring Rose to file the terminal disclaimer and to cancel claim 100 (and file a divisional if desired) is intended to minimize any term extension Rose might receive based on the delay. (See Paper 32 at 3).

Based on the record of the interference and the reasons set forth in the arbitrator's decision on preliminary motions (Paper 31), it is appropriate to:

- (1) substitute Count 2 for Count 1, and
- (2) designate Wertz claims 1, 5, 6, and 10 and Rose claims 75-99 and 101-132 as corresponding to Count 2.

Based on the record of the interference and the reasons set forth in the arbitrator's decision on priority (Paper 38), it is appropriate to enter judgment on priority as to Count 2 against Wertz.

III. Order

Upon consideration of the record of the interference and for other reasons given, it is

ORDERED that the interference is redeclared to the following extent:

- (1) The following count, Count 2, is substituted for Count 1:

A virus particle of claim 1, wherein the non-segmented RNA virus is vesicular stomatitis virus (VSV). [Wertz claim 5]

OR

A virus particle of claim 6, wherein the non-segmented RNA virus is vesicular stomatitis virus. [Wertz claim 10]

OR

A modified recombinant replicable vesiculovirus, comprising vesiculovirus N, P, and L proteins, and a replicable vesiculovirus genomic sense (-) RNA, in which said genomic sense (-) RNA, is modified by:

- (a) the insertion of a foreign or heterologous RNA sequence into a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA; or

- (b) the replacement of a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA with a foreign or heterologous RNA sequence;

in which an RNA sequence complementary to said foreign RNA sequence encodes a peptide or protein. [Rose claim 75, as amended]

OR

A modified inactivated recombinant vesiculovirus that is the produce of a method comprising inactivating a recombinant replicable vesiculovirus, said recombinant replicable vesiculovirus comprising N, P, and L proteins, and a replicable vesiculovirus genomic sense (-) RNA, in which said genomic sense (-) RNA, is modified by:

- (c) the insertion of a foreign or heterologous RNA sequence into a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA; or
- (d) the replacement of a nonessential portion of said replicable vesiculovirus genomic sense (-) RNA with a foreign or heterologous RNA sequence;

in which an RNA sequence complementary to said foreign RNA sequence encodes a peptide or protein. [Rose claim 103, as amended]

OR

A pure, recombinant, replicating and infectious vesicular stomatitis virus (VSV) particle, comprising:

- 1) a functional RNA dependent RNA polymerase (L);
- 2) a vesiculovirus phosphoprotein (P);
- 3) a vesiculovirus nucleocapsid (N);
- 4) vesiculovirus protein selected from the group consisting of glycoprotein (G) and matrix (M)
- 5) a 3' non-coding RNA sequence;
- 6) a 3' to 5' RNA coding sequence, which encodes the vesiculovirus L, P, N, and vesiculovirus protein required for assembly of budded infectious particles and includes a heterologous gene (X), wherein said heterologous gene (X) is inserted at an intergenic junction; and
- 7) a 5' non-coding RNA sequence, and wherein components 1 through 7 are from the same type of VSV. [Rose claim 132, unamended], and

(2) The following claims are designated as corresponding to Count 2:

Wertz: 1, 5, 6, and 10

Rose: 75-99 and 101-132;

FURTHER ORDERED that judgment on priority is awarded against GAIL W. WERTZ, QINGZHONG YU, LAURENCE A. BALL, JOHN N. BARR, AND SEAN P.J. WHELAN as to Count 2;

FURTHER ORDERED that GAIL W. WERTZ, QINGZHONG YU, LAURENCE A. BALL, JOHN N. BARR, AND SEAN P.J. WHELAN is not entitled to a patent containing claims 1, 5, 6, and 10 of patent 5,789,229 that correspond to Count 2;

FURTHER ORDERED that a copy of the terminal disclaimer filed by Rose (Paper 33) shall be given a paper number and entered in Rose's 08/435,032 application;

FURTHER ORDERED that a copy of the amendment filed by Rose canceling claim 100 (Paper 34) shall be given a paper number and entered in Rose's 08/435,032 application;

FURTHER ORDERED that a copy of this decision shall be given a paper number and entered in the administrative records of Wertz's 5,789,220 patent and Rose's 08/435,032 application; and

FURTHER ORDERED that if there is a settlement agreement in the interference, the parties are directed to 35 USC § 135(c) and 37 CFR § 1.666.

RICHARD E. SCHAFFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

SALLY GARDNER LANE
Administrative Patent Judge

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